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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,162	02/13/2001	Kazuma Sato	862.C2116	9463
5514	7590	01/06/2006	EXAMINER	SHAH, AMEE A
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT	PAPER NUMBER
3625				
DATE MAILED: 01/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/781,162	SATO ET AL.	
Examiner	Art Unit		
Amee A. Shah	3625		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 September 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-43 is/are pending in the application.  
4a) Of the above claim(s) 3 and 17-43 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1,2 and 4-16 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 May 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All   b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_.  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 6, 2005, has been entered.

***Response to Amendment***

The Amendment received on September 6, 2005, is acknowledged and entered. The applicant has canceled claims 3 and 17-43 and amended claims 1, 4-7, 9-12, and 14-16. Currently, claims 1, 2, and 4-16 are pending for examination.

The Amendment received on September 6, 2005, regarding the specification and claims 4, 5, 6, 9, 10, 11, 14, 15 and 16 is accepted. In view of these amendments, the objections and 35 U.S.C. §112 first and second paragraph rejections regarding the specification and claims 4, 5, 6, 9, 10, 11, 14, 15 and 16 are withdrawn.

***Response to Arguments***

Applicant's arguments filed September 6, 2005, have been fully considered but they are not persuasive. With regards to applicant's argument that Farrell does not disclose or suggest the limitations of claim 1 relating to receiving information of a number of printed sheets and

calculating a payable amount based on the number of printed sheets and a charge amount (Remarks, pages 11 and 12), Examiner respectfully disagrees. As discussed below, Farrell does suggest receiving a number of printed sheets (col. 8, lines 56-64) and calculating payable amount based on this number and a variety of charge amounts (col. 7, lines 35-45 and col. 8, lines 56-60).

In response to applicant's argument that Farrell fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies, i.e., determining the cost of a maintenance agreement for maintaining the apparatus (Remarks, page 12), are not recited in the rejected claim(s). Claims 1, 7 and 12 recite that limitation of calculating a payable amount, which Farrell discloses (see below), not cost of a maintenance agreement. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has not presented any arguments rebutting that the limitation of claims 1, 7, and 12 of storing a variety of charge amounts is anticipated or obvious in view of the prior art Farrell. Therefore, the evidence is considered in rejecting the limitations of these claims as admitted prior art by the applicant.

#### ***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Amended claims 6, 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Amended claims 6, 11 and 16 contain the amended limitation of “an input section that inputs an instruction sent by an external computer for instructing (i) a type of agreement and (ii) a period of the type of agreement instruction window displayed by the external computer” (Remarks, pages 5, 7, and 9). It is not clear to one skilled in the art what is meant by “a period of the type of agreement instruction window displayed by the external computer.” For examining purposes only, the examiner will interpret “a period of the type of agreement instruction window displayed by the external computer” to mean a period of the type of agreement input through an instruction window displayed by the external computer.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 5, 7, 8, 10, 12, 13 and 15 are rejected under 35 U.S.C. 103 as being unpatentable over Farrell (US Pat. No. 5,383,129).**

Referring to claim 1. Farrell discloses an information processing system for managing plural types of maintenance agreements relating to image forming apparatuses, comprising:

- a receiver that receives a number of printed paper sheets from an image forming apparatus via a communication path (Fig. 10, col. 5, lines 51-67, and col. 8, lines 56-64 – note that the receiver is the system controller, the number of printed paper sheets is the number of

reprographic system functions and the communication path is the control section including processors for transmitting data);

- a memory that stores a variety of charge amounts per paper sheet to be output by the each of the image forming apparatuses, in accordance with the types of maintenance agreements of a content of services by a serviceman of the image forming apparatuses, corresponding to each of the image forming apparatuses; (col. 7, lines 35-45 and col. 8, lines 37-56 – note that the variety of charge amounts are stored depending upon the different billing rates for different functions (col. 7, lines 35-45) and upon the type of printing material (col. 8, lines 37-56) to be used in calculating the charge amount per sheet); and

- a calculation section that calculates a payable amount on the basis of (i) the number of printed paper sheets received by said receiver and (ii) a charge amount of the variety of charge amounts stored in said memory for in correspondence with the image forming apparatus from which the number of printed paper sheets is received (Fig. 11, col. 7, lines 35-45 and col. 8, lines 56-60).

Farrell does not expressly show the stored charge amounts being in accordance with the types of maintenance agreements of a content of services by a serviceman of the image forming apparatuses corresponding to each of the image forming apparatuses. As analyzed above, Farrell shows the stored charge amounts in accordance with the different billing rates and types of printing materials. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the storing step recited. The storing of a variety of charges would be performed in the same manner regardless of whether the charges are based on maintenance agreements, billing rates or types of printing materials. Thus, the non-functional

descriptive material will not distinguish the claimed invention from the prior art Farrell in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to store charges based upon any criteria, such as types of maintenance agreements, billing rates or types of printing materials, because such criteria does not functionally relate to the storing step and also because the subjective interpretation of the criteria does not patentably distinguish the claimed invention.

Referring to claim 2. Farrell further discloses the system according to claim 1,

- wherein said memory stores a first charge amount per printed sheet in correspondence with an agreement of a first type and a second charge amount per printed sheet in correspondence with an agreement of a second type (col. 8, lines 37-56 – note that the agreement of a first type is the printing material type and the agreement of the second type is the unit cost);
  - wherein the contents of services under each of the agreements of the first type and the second type differ from each other (col. 8, lines 37-56 – note that the printing material type and unit cost are inherently capable of differing from each other); and
    - wherein the amount of the second charge is an additional amount of the first charge and a predetermined amount (col. 8, lines 43-48 – note that the predetermined amount is the reference value).

Referring to claim 5. Farrell further discloses the system according to claim 4, further comprising:

- a retrieval section for retrieving agreement information of a most suitable agreement based upon running information based on the information of the number of paper sheets, of the image forming apparatuses (Fig. 11 and col. 8, line 10 through col. 9, line 13 – note that the retrieval section is step 518 which obtains a unit cost for each printing materials type from the database and a most suitable agreement is an agreement most suitable according to the user's preferences which can be based on the number of sheets); and
- an information section that informs a user of a result of retrieval by said retrieval section (Figs. 11 and 12 and col. 9, lines 14-29 – note the information section is step 522 wherein an invoice showing the various printing material type costs is generated and shown).

Referring to claims 7, 8, 10, 12, 13 and 15. All of the limitations in method claims 7, 8, and 10 and apparatus claims 12, 13 and 15 are closely parallel to the limitations of system claims 1, 2, and 5 analyzed above and are rejected on the same bases.

**Claims 4, 6, 9, 11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell in view of Lacheze et al., U.S. Patent No. 5,956,698.**

Referring to claims 4 and 6. Farrell discloses the system according to claim 1 further comprising wherein said calculation section calculates the payable amount based upon (i) a charge amount per printed sheet in accordance with the agreement instructed by the instruction input by said input section and (ii) the number of printed sheets received by said receiver (col. 7,

lines 35-45). Farrell does not disclose an input section that inputs an instruction for instructing an agreement sent from an external computer, nor wherein the instruction instructs (i) a type of agreement and (ii) a period of the type of agreement input through an instruction window displayed by the external computer.

Lacheze et al., in the same field of endeavor of methods for printing systems, discloses a system for producing copies or prints based on a set of accounting information accumulated and stores in an accounting subsystem, including an input section that inputs an instruction sent from an external computer through an agreement instruction window that instructs a type and period of agreement (col. 5, lines 23-39 and col. 8, lines 25-51 – note the input section is the Application Layer, the agreement instruction window is the application programming interface at the host computer and the type and period of agreement input through an instruction window is the UI description)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Farrell to include the teachings of Lacheze et al. to allow for an input section that inputs an instruction sent from an external computer through an agreement instruction window that instructs a type and period of agreement. Doing so would allow for a user to interact with the printing system, via a network, to obtain an optimum billing rate, as explicitly disclosed by Lacheze et al. (col. 2, lines 43-67).

Referring to claims 9, 11, 14 and 16. All of the limitations in method claims 9 and 11 and apparatus claims 14 and 16 are closely parallel to the limitations of system claims 4 and 6 analyzed above and are rejected on the same bases.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (1) Maruta et al., U.S. Patent No. 6,516,157 B1, discloses a printing system whereby a print request is sent from a user side processor, a cost is calculated and transmitted back via a network (*see, e.g.*, cols. 5-25); (2) Leni et al., U.S. Patent No. 6,498,912 B1, discloses a job-based accounting method and apparatus for image processing (*see, e.g.*, cols. 2-7); (3) Iwata, JP Patent No. 02136870 A, discloses a system to store counted data and calculate price (*see Abstract*); and (4) Ikeda, JP Patent No. 09138621 A, discloses a system where a copying charge is changed in accordance with toner consumption (*see Abstract*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

January 3, 2006

*Alyce*  
Y. C. GARC  
Primary Examiner